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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,991	12/14/2005	Fraser Harvie	PT-2655-US-PCT	9555
68622	7590	09/24/2009		
NORMAN F. HAINER, JR. SMITH & NEPHEW, INC. 150 MINUTEMAN ROAD ANDOVER, MA 01801			EXAMINER LEWIS, RALPH A	
			ART UNIT 3732	PAPER NUMBER
			MAIL DATE 09/24/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/540,991

**Applicant(s)**

HARVIE ET AL.

**Examiner**

Ralph A. Lewis

**Art Unit**

3732

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 29, 50, 64-69, 72-75, 78-80 and 82 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29, 50, 64-69, 72-75, 78-80 and 82 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **Acknowledgement of Request for Continued Examination**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 13, 2009 has been entered.

### **Rejections based on Prior Art**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 29, 50, 67, 72-75, 78-80 and 82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harvie et al (US 6,620,185) in view of Harwin et al (US 5,618,314).

Initially, it is noted that the present application does not claim priority back to the 09/604,387 application (6,620,185 patent) and that the earlier patent (Harvie et al) has a different inventive entity from the present application.

Harvie et al disclose a handpiece 52 having a cannulated tube 71 mounted on the handpiece 52 and having a tip through which a suture 70 is received, carried, and

dispensed. The Harvie et al cannulated tube 71 includes a heating device 188 disposed therein. In regard to the "suture carrying device" limitation, Harvie et al indicates that the suture 70 may include a rigid shaped member 410 (Figure 21F) for increasing the resistance to the suture from being pulled out of the bone. The Harvie et al suture carrying device 410 does not include the claimed eyelet, pair of channels or the cannula tip portion with flat areas for restricting rotation of the suture carrying device. Harwin et al, however, teach a similar suture anchoring device having an eyelet 30 for receiving a suture and a pair of channels 50 for engaging a flattened keying area 280 (Figure 8B) of the cannulated tube insertion tool so that the suture carrying device can be easily manipulated and controlled. To have formed the Harvie et al suture carrying member 410 (Figure 21F) with an eyelet and channels that cooperate with the Harvie et al cannulated tube so that the suture carrying device may be more accurately manipulated and controlled would have been obvious to one of ordinary skill in the art in view of the teaching by Harwin et al.

In regard to claim 67, note tube 186 which inherently has some insulating properties.

Claims 64 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harvie et al (US 6,620,185) and Harwin et al (US 5,618,314) in view of Doi et al (US 3,584,198).

Harvie et al fail to disclose the structure of heating element 188. Merely selecting a conventional off the shelf flexible foil heating element as that disclosed by Doi for the

heating element 188 of Harvie et al would have been obvious to one of ordinary skill in the art as a matter of routine practice in carrying out the Harvie et al invention.

Claims 65, 68 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harvie et al (US 6,620,185) and Harwin et al (US 5,618,314) in view of Lavenuta (US 6,660,554).

Harvie et al fail to disclose the operation and control of heating element 188. The use of thermistors for controlling the heat output from such heaters is conventional to prevent over heating, note Lavenuta column 1, lines 22-35. Merely selecting conventional off the shelf thermistors as that disclosed by Lavenuta for controlling the heating element 188 of Harvie et al in order to prevent overheating would have been obvious to one of ordinary skill in the art as a matter of routine practice in carrying out the Harvie et al invention.

#### **Applicant's Remarks**

Applicant's remarks filed with the amendment of July 13, 2009 have been carefully considered and addressed in the grounds of rejection above.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication should be directed to **Ralph Lewis** at telephone number **(571) 272-4712**. Fax (571) 273-8300. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Cris Rodriguez, can be reached at (571) 272-4964.

R.Lewis  
September 22, 2009

/Ralph A. Lewis/  
Primary Examiner, Art Unit 3732